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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/869,458	06/26/2001	Yasuyuki Miyazawa	1576.89	4193

7590

02/04/2003

Mason & Associates  
17757 US Hwy 19 North Suite 500  
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EXAMINER
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HABTE, KAHSA Y

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 02/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/869,458

Applicant(s)

MIYAZAWA ET AL.

Examiner

Kahsay Habte, Ph. D.

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 July 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 7-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

1. Claims 1-34 are pending.

***Election/Restriction***

2. Applicant's election of Group I with traverse is acknowledged. No reasons were given for the traverse.

***Abstract***

3. The abstract is defective because there are no chemical structures that correspond to the formula (1) or compounds (2 and 3). It is recommended that applicants draw the chemical structures.

***Information Disclosure Statement***

4. The information disclosure statement filed on Sept. 12, 2001 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. Two references (Tetrahedron Vol. 44, No 12, pp 3727-3274, 1998 and EP 0769495) are missing. Applicants are kindly requested to provide said references.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Clough et al. (US. Pat. No. 5,021,581). The cited reference teaches the synthesis of Formula (II) (column 23,  $R^5 = H$ ) that is obtained by treating phenylacetate derivative represented by Formula (III) with methyl formate in the presence of a base (see scheme 1 and column 21 last paragraph). Said Formula (II) is the same as applicants when applicant's formula (II) has the following substituents:

$R_1$  = optionally substituted aryl,  $X = O$ , and  $R_2$  = methoxy.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention:

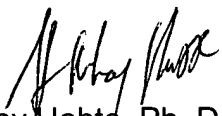
- a. Claim 1 and claims dependent thereon are rejected because in claim 1 (line 11), the term alkyl is written as "alykl".
- b. In claim 1 (line 17), the term "optiobally" should read as "optionally".
- c. In claim 1 (last line), substituted is misspelled as "substitued".
- d. In claim 1 or elsewhere in the claim, the phrase "optionally substituted" is indefinite. What are covered and what are not? Applicants have to recite the substituents assuming that there is enough support in the specification. For example, optionally substituted by C1-C20 alkyl is acceptable.
- e. In claim 1, the phrase "heterocyclic group" is indefinite. What is the size of the ring? What is the number and nature of the heteroatoms? Can the ring be fused or spiroconnected to another ring, and if so, what kind of ring? Can the ring be bridged? Unsaturated? Cf *In re Wiggins*, 179 USPQ 421, 423.
- f. In claim 1 or elsewhere in the claims, the phrase "general formula" is indefinite. A formula cannot be a general one. It is recommended that applicants delete "general" from said phrase.

**Conclusion**


7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kahsay Habte, Ph. D. whose telephone number is (703) 308-4717. The examiner can normally be reached on M-F (9.00AM- 5:30PM).

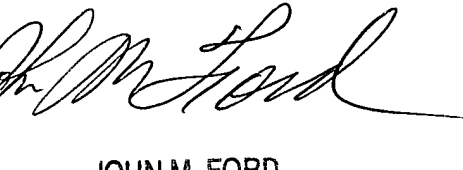
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on 703-308-4716. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

  
Kahsay Habte, Ph. D.  
Examiner  
Art Unit 1624

KH  
January 30, 2003

 Mukund J. Shah  
Supervisory Patent Examiner  
Art Unit 1624

  
JOHN M. FORD  
PRIMARY EXAMINER  
GROUP - ART UNIT 1624